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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,764	10/07/1999	SUZANNE M. PAULEY	460.1791USU	3820

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 08/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

<b>Office Action Summary</b>	Application No. 09/414,764	Applicant(s) PAULEY ET AL.	
	Examiner Dennis Ruhl	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 7-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 10 June 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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Applicant's response of 6-10-02 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The amendment filed 6-10-02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Figure 1 is new matter. It was not previously known what a "bell" shape was and now applicant has introduced a specific figure that shows a bell shape. This is new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1,16,18, what is meant by "than just prior to ejection"? Applicant is reciting a diameter for the tampon but is relating it to a size of the tampon "just prior to ejection". What is considered to be just prior to ejection? If the examiner has no idea what the size of the tampon was "just prior to ejection", then how can the examiner confidently address the diameter limitation added to the claims? What is considered to be ejection? Is that when the entire pledget is ejected or does this allow for a situation where 80% of the pledget is ejected but 20% remains inside the applicator? In that case 80% of the tampon would be allowed to expand while the 20%

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inside the applicator is still being restrained. Does the claim then require that the 80% must expand further by 25-300%? The added language of the claims is considered to be indefinite.

With respect to claim 15, the examiner is not clear what a "bell" shape is. There are no figures in this application showing the shape of a bell so this limitation is considered indefinite. Is this supposed to mean a shape like the liberty bell, or a bell pepper or a diving bell? The scope of this claim is not clear to the examiner.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3,5,8-11,14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Matthews (4335721).

Matthews discloses a tampon with a coverstock that is made from a mixture of absorbent and non-absorbent fibers as claimed. Matthews discloses the claimed type of fibers in the claimed ratio. See column 2, lines 19-56. The examiner considers Matthews to disclose a bell shape. For claim 20, applicant never recited that the fibers are made from the claimed types and the claim is satisfied by the Markush group of claim 18. The scope of the claim has not been narrowed down from the scope of the Markush grouping. With respect to the limitation of "wherein immediately after ejection .....than just prior to ejection" the examiner does not feel that this limitation claims anything not found in the prior art. The prior art is fully capable of being

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compressed and placed in a applicator and after ejection will expand as claimed. The amount of expansion clearly depends on the diameter prior to ejection and this depends on the size (diameter) of the applicator itself, so the prior art is capable of being compressed by more than 25%, placed in an applicator and then expelled and allowed to return to its original dimensions. The prior art is fully capable of what is claimed.

6. Claims 1,9,14,15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lloyd et al. (5374258).

Lloyd discloses a tampon with a coverstock that is made up of absorbent and non-absorbent fibers as claimed. See column 2, lines 51-57. The examiner considers Lloyd to disclose a bell shape. With respect to the limitation of "wherein immediately after ejection .....than just prior to ejection" the examiner does not feel that this limitation claims anything not found in the prior art. The prior art is fully capable of being compressed and placed in a applicator and after ejection will expand as claimed. The amount of expansion clearly depends on the diameter prior to ejection and this depends on the size of the applicator itself, so the prior art is capable of being compressed by more than 25%, placed in an applicator and then expelled and allowed to return to its original dimensions. The prior art is fully capable of what is claimed.

7. Claims 1-3,5,7-11,13,14,16,18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Foley et al. (5817077).

Foley discloses a tampon that is made with absorbent and non-absorbent fibers as claimed. Foley discloses the claimed type and claimed ratio of fibers. The tampon has a coverstock. See column 5, lines 36-60. Foley discloses the claimed denier for

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the fibers. For claim 20, applicant never recited that the fibers are made from the claimed types and the claim is satisfied by the Markush group of claim 18. The scope of the claim has not been narrowed down from the scope of the Markush grouping. With respect to the limitation of "wherein immediately after ejection .....than just prior to ejection" the examiner does not feel that this limitation claims anything not found in the prior art. The prior art is fully capable of being compressed and placed in a applicator and after ejection will expand as claimed. The amount of expansion clearly depends on the diameter prior to ejection and this depends on the size of the applicator itself, so the prior art is capable of being compressed by more than 25%, placed in an applicator and then expelled and allowed to return to its original dimensions. The prior art is fully capable of what is claimed.

8. Claims 1-3,5,8-11,15,16,18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Olofsson et al. (3986511).

Olofsson discloses a tampon that is made from a mixture of absorbent and non-absorbent fibers as claimed. See column 3, lines 8-44. Olofsson discloses the claimed type and ratio of fibers. The examiner considers Olofsson to disclose a bell shape. For claim 20, applicant never recited that the fibers are made from the claimed types and the claim is satisfied by the Markush group of claim 18. The scope of the claim has not been narrowed down from the scope of the Markush grouping. With respect to the limitation of "wherein immediately after ejection .....than just prior to ejection" the examiner does not feel that this limitation claims anything not found in the prior art. The prior art is fully capable of being compressed and placed in a applicator and after

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ejection will expand as claimed. The amount of expansion clearly depends on the diameter prior to ejection and this depends on the size of the applicator itself, so the prior art is capable of being compressed by more than 25%, placed in an applicator and then expelled and allowed to return to its original dimensions. The prior art is fully capable of what is claimed.

9. Applicant's arguments filed 6-10-02 have been fully considered but they are not persuasive.

With respect to the traversal of the 112,2<sup>nd</sup> paragraph rejection of claim 15 the argument is non-persuasive. Applicant has stated that because the application now contains a figure that shows a bell shape, the scope of the term "bell shape" is "now clear and definite". The examiner has determined the figure to be new matter and the scope of the term as of the filing date of the application is still not known. In hindsight the examiner probably should not have objected to the drawings to avoid the new matter situation that is now an issue in the instant application. The figure is not approved and the scope of this term is still considered indefinite.

With respect to the traversal of the prior art rejections, the traversal is non-persuasive. The amount of expansion after expulsion directly depends on how much compression there is prior to ejection. That would depend on the diameter of the applicator itself. One could take the same tampon and eject it from two differing diameter applicators and come up with two different percentages of expansion, even though the tampon is the same structurally. The examiner considers the prior art to satisfy the limitation that has been argued. Additionally the claim allows for the tampon

to contact water after ejection and could have its expansion attributed to that. Applicant is relying upon an intended use functional recitation for patentability of an article, which in this case is non-persuasive.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Tuesday through Friday.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DR  
August 13, 2002



**DENNIS RUHL**  
**PRIMARY EXAMINER**